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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,573	02/08/2001	Samuel Sergio Tenenbaum		4194

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EXAMINER

JASMIN, LYNDY C

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/778,573

Applicant(s)

TENEMBAUM, SAMUEL SERGIO

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Amendment received February 14, 2005 has been acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 and 2-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide an adequate written of the lenders being a non-professional investor. Who are the non-professional investors? *No new matter will be allowed to be entered into the specification or drawing figures.*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 1 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed February 14, 2005. In that paper, applicant has stated "One of the primary features of the present invention is that it provides a market place in which

non-professionals can invest”, and this statement indicates that the invention is different from what is defined in the claim(s) because applicant as amendment claim to cancel the language of the specification where the lenders is “one of an individual investor” to emphasis on a non-professional investor.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. As best understood, claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talbort et al. (2002/0116312 A1), in view of Tengel et al. (5,940,812).

Talbort et al. discloses a method of creating an online marketing environment (OLME) comprising the steps of providing a community of reverse credit auctions (via a reverse blind electronic credit auction) including borrowers and lenders connected to a computer network (via network 110) through their respective computing devices (via 102, 104, 106) in which each auction includes borrowers who presents a buyer's credit needs and collaterals and a subgroup of the lenders which may include all of the lenders, who analyze the auctions on a caveat emptor basis and compete to provide credit to the borrower in an auction by adjusting the interest rates offered to the borrower (as illustrated in the background of the invention, having an online loan

marketplace where *lenders* bid for borrower's business and allow *borrowers* to choose among multiple loan offers including terms and *rates*).

Talbort et al. further discloses at least one of the lenders is a professional (see page 4; box 0047). The at least one borrowers includes one of an entity having current access to the traditional asset based financial market (via borrowers bidding for financial institution's products). At least one or more support player connected to the network through a respective computing device (via client devices), the support player being an entity from the group consisting of: credit rating companies and personal credit rating companies (via credit report 302 is obtained from one, or more, of many credit reporting services).

Talbot does not explicitly disclose that the lender is a non-professional investor. However, Tengel et al. discloses the concept of matching a loan to a potential borrower via a global telecommunications network where the lenders are, for example, entity in the business of originating loans. They are not affiliated in any way other than in their participation in the loan market as competitors for loans.

From this teaching of Tengel, it would have obvious to one of ordinary skill in the art at the time the invention was made to modify the online market of Talbort et al. to include the different group of lenders taught by Tengel in order to facilitate rankings of best loans.

8. Claims 6-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Talbort in view of Tengel combination, as applied to claim 1 above, and further in view of Kocher (2003/0061150 A1).

As best understood, the Talbort and Tengel combination discloses the elements of the claimed invention, but fails to explicitly the different type of auctions.

Kocher discloses the concept of having performing electronic transaction including Dutch (split) or English (bulk or split) auction (similar to e-Bay [109]), where borrowers further pertain to secondary market (via 20). The revenue sources are through pawn lending rates. Kocher further discloses that the loans are designed for credit card financing (via a collateralized credit card). Thus, one of ordinary skill in the art at the time the invention was made to have provided the online market of the Talbort and Tengel combination to include the Dutch and English auction taught by Kocher in order to achieve a winning bid.

9. Claim 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Talbort in view of Tengel combination, as applied to claim 1 above, and further in view of Kaplan et al. (2002/0095369 A1).

The Talbort and Tengel combination discloses the elements of the claimed invention, but fails to categorize the loans.

Kaplan et al. discloses the concept of having an electronic marketplace where bonds are submitted for an auction or PriceMatch.

From this teaching of Kaplan et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the electronic credit auction of Talbort et al. and the matching of best loans of Tengel to include the categorized auction system taught by Kaplan et al. for the purpose of utilizing a recognized,

independent and reputable transaction clearing entity to guarantee all trades executed on the system.

Response to Arguments

10. Applicant's arguments with respect to claims 1, 34-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Erlanger discloses an online processing system for providing efficient market for loans and lines of credit.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

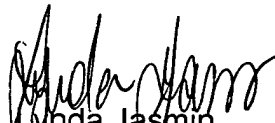
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (571) 272-6782. The examiner can normally be reached on Monday- Friday (9:30-6:00) with Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Lynda Jasmin
Primary Examiner
Art Unit 3627
5/24/05

lj